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09/838,970	04/20/2001	George Daryl Blankenship	LINCP105US	1244
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AMIN, TUROCY & CALVIN, LLP			EXAMINER	
127 Public Square			DUNHAM, JASON B	
57th Floor, Key Tower				
CLEVELAND, OH 44114			ART UNIT	PAPER NUMBER
			3625	
			NOTIFICATION DATE	DELIVERY MODE
			11/17/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket1@thepatentattorneys.com  
hholmes@thepatentattorneys.com  
lpasterchek@thepatentattorneys.com

# Office Action Summary

**Application No.**

09/838,970

**Applicant(s)**

BLANKENSHIP ET AL.

**Examiner**

JASON B. DUNHAM

**Art Unit**

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-58 is/are rejected.
- 7) ☒ Claim(s) 55-57 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

Applicant amended claims 37, 38, 43, and 55-57 and added claim 58 in the response filed April 23, 2008 in reply to the office action dated January 23, 2008. Claims 1-58 are pending. Applicant's amendments to claims 55-57 rendered the previous objection moot.

### **Claim Rejections - 35 USC § 101**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 37-44 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Referring to claim 38. This claim is directed to a "system" for managing welding consumables. The system has three parts: (1) a consumable monitor "component", (2) a customer "component", and (3) a supplier "component." The Applicants' specification defines a "component" as follows:

*"A 'component' is a computer-related entity, either hardware, a combination of hardware and software, software, or software in execution. For example, a component may be, but is not limited being, a process running on a processor, a processor, an object, an executable, a thread of execution, a program and a computer. By way of illustration, both an application running on a server and the server can be components." (see page 5, lines 15-20).*

Thus the Applicants' specification teaches that a "component" can be construed as a program (i.e. software). Therefore, the "system" of claim 38 comprises three programs. The Examiner notes that a program or software is nothing more than a series of instructions to perform an action (i.e. an algorithm) (see Microsoft Press Dictionary). Hence, the Applicants' "system" can be construed as comprising three algorithms. None of these "components" recite anything physical to constitute a "system" (i.e. an apparatus) (see MPEP 2106.01(I)). The examiner notes that applicant amended the claim to recite a "memory"; however the memory is not embodied in a medium and given its broadest reasonable meaning, memory is construed as software. Furthermore, the claim merely recites the memory is "coupled" to the consumable monitor component and does not indicate how the components are structurally related to the memory.

Referring to claims 37, 43, and 44. Claims 37, 43, and 44 are rejected under the same rationale as set forth above in claim 38.

Referring to claims 39-42. Claims 39-42 are dependent on claim 38. However, these claims fails to correct the deficiency of claim 38 and are rejected under the same rationale as set forth above in claim 38.

**Claim Rejections - 35 USC § 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-48 and 50-58 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1, 37, 38, 43, 45, 48, 50, and 54 recite the limitation "...information that includes an indication of ownership of a welding consumable(s)..." This limitation does not have proper written description support in the specification. The Applicant's specification discloses that a supplier can maintain an inventory of welding consumables at a customer location (i.e. vendor managed inventory) (see specification page 10, lines 4-6; page 20, lines 19-21). However, the specification fails to disclose a welder that transmits information including "...an indication of ownership of a welding consumable(s)..."

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 37-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Referring to claim 38: Claim 38 is directed to a "system". However, as noted above in the 101 analysis, Applicants' invention can be construed as comprising three algorithms. It is unclear to the Examiner how three algorithms can constitute a "system" (i.e. apparatus) since an algorithm has no physical structure.

Referring to claims 37, 43, and 44: Claims 37, 43, and 44 are rejected under the same rationale as set forth above in claim 38.

Referring to claims 39-42: Claims 39-42 are dependent on claim 38. However, these claims fail to correct the deficiency of claim 38 and are rejected under the same rationale as set forth above in claim 38.

Referring to claims 55-57. It has been held that a claim that recites both an apparatus and a method for using said apparatus is indefinite under section 112, paragraph 2, as such a claim is not sufficiently precise to provide competitors with an accurate determination of the 'metes and bounds' of protection involved-IPXL Holdings LLC v. Amazon.com Inc., 77 USPQ2d 1140 (CA FC 2005); Ex parte Lyell, 17 USPQ2d 1548 (B.P.A.I. 1990)

A single claim which purports to be both a product or machine and a process is ambiguous and is properly rejected under 35 USC 112, second paragraph, for failing to particularly point out and distinctly claim the invention-Ex Parte Lyell, 17 USPQ2d 1548 (B.P.A.I. 1990).

**Claim Rejections - 35 USC § 103**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Niedereder et al. (US 6,797,921 B1) in view of Mottishaw et al. (US 6,721,284 B1) ("Mottishaw").**

Niedereder teaches a method for managing welding consumable(s), comprising:

- receiving information from a monitor that evaluates consumable(s) related to a welder via a computer network regarding consumable usage (*col. 5, lines 25-46; col. 11, lines 28-52*);
- receiving information regarding weld quality (*col. 5, lines 32-36*).

Niedereder does not teach invoicing a customer for the consumable based at least in part upon the information received regarding the consumable usage and the weld quality. However, Mottishaw discloses a method of generating records that bills (i.e. invoicing) based on the quality of service delivered and usage of the service (*col. 8, lines 37-44; claim 10*). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the billing practice of Mottishaw into the invention of Niedereder. One of ordinary skill in the art would have been motivated to do so in order to bill a customer based on the quality and usage of a service.

***Response to Arguments***

Applicant's arguments filed April 23, 2008 have been fully considered but they are not persuasive.

Applicant argues that the 35 USC 101 rejection to claims 37-44 is improper. The examiner disagrees and notes the newly stated rationale contained the in the rejection of claims 37-44 above. The 35 USC 112, second paragraph rejection to claims 37-44 is also maintained under this rationale.

Applicant further argues that the rejection of claims 1-48 and 50-58 under 35 USC 112, first paragraph is improper by noting portions of page 10 of the specification. The examiner disagrees; the cited portion of the specification relates to usage of welding consumables while indicating that supplier maintains a inventory of the consumables, however the specification does not indicate how the welder transmit information that indicates ownership.

Applicant further argues that the combination of Niedereeder and Mottishaw does not disclose all the claimed features of claim 49.

The applicant specifically argues that Niedereeder does not disclose welding quality. The examiner disagrees; column 5, line 32-36 disclose "assessing the quality and productivity of the welding process".

Applicant further argues that Mottishaw does not teach invoicing based on the quality and usage of service delivered because Mottishaw does not specifically disclose welding services. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually



where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Niedereder discloses receiving information regarding welding services and Mottishaw discloses invoicing based on service; therefore these references properly combined render claim 49 obvious.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one of ordinary skill in the art would have been motivated to do so in order to bill a customer based on the quality and usage of a service. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON B. DUNHAM whose telephone number is (571)272-8109. The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey A. Smith/  
Supervisory Patent Examiner, Art  
Unit 3625

JBD  
Patent Examiner  
11/9/08